

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**Applicant: LANDIS *et al.*

Title: DIAZAPHOSPHACYCLES


Appl. No.: 09/911,367

Filing

Date: July 23, 2001

Examiner: Jon D. Epperson

Art Unit: 1639

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| <b>CERTIFICATE OF MAILING</b><br>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: MAIL STOP Issue Fee, Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450, on the date below.<br><br>Bernard P. Friedrichsen<br>(Printed Name)<br><br>(Signature)<br><i>February 20, 2004</i><br>(Date of Deposit) |
|---|

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT  
DETERMINATION UNDER 35 U.S.C. § 154(b)(3)(B)(ii)**

MAIL STOP Issue Fee  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Applicants are in receipt of the Notice of Allowance dated February 10, 2004, allowing claims 24, 29-32, 37-39, and 44-47. The issue fee has not yet been paid for this application. Applicants thank Examiner Epperson for allowing the claims of the application. However, Applicants disagree with the Determination of Patent Term Adjustment (PTA) under 35 U.S.C. § 154(b) and present the following facts set forth in 37 C.F.R. § 705 to support their contention that the patent term adjustment should be 372 days based on the projected grant date instead of the 211 days calculated by the United States Patent and Trademark Office (USPTO).

**BASIS FOR THE ADJUSTMENT**

A Notice to File Missing Parts was mailed to Applicants on September 26, 2001, with a due date for response of November 26, 2001. Applicants filed a Response to the Notice to File Missing Parts on November 30, 2001, along with a Petition for One

Month Extension of time, two (2) executed Declaration and Power of Attorney forms (the first executed by three of the four inventors including Clark R. Landis, Wiechang Jin, and Thomas P. Clark, and the second executed by the fourth inventor, Jonathan S. Owen), two checks for the requisite filing and petition fee, and a return receipt postcard. Applicants received the return receipt postcard for the Response to the Notice to File Missing Parts stamped as received by the Office of Initial Patent Examination (OIPE) on January 11, 2002 (copy enclosed). The OIPE-stamped return postcard indicated that both Declarations had been received. A Notice of Incomplete Reply was mailed to Applicants on February 26, 2002, which erroneously indicated that the signature of inventor Jonathan S. Owen was missing from the Declaration. In response, Applicants filed a Response to Notice of Incomplete Reply on March 5, 2002, via facsimile to Joyce Riley of the USPTO, that included copies of each of the documents filed on November 30, 2001, including the OIPE-stamped return postcard, and requested that the Notice of Incomplete Reply be withdrawn. On March 6, 2002, Applicants further filed via first class mail, a Response to the Notice of Incomplete Reply that also included a copy of each of the documents filed on November 30, 2001, a copy of the OIPE-stamped return postcard, and a new return receipt postcard for the filing of the Response to Notice of Incomplete Reply. Applicants again requested withdrawal of the Notice of Incomplete Reply.

The Calculation of PTA by the USPTO, as shown in the following Table copied from the USPTO website, shows that the USPTO calculated the PTA using an Applicant delay of 145 days for late response to the Notice of Missing Parts mailed on September 26, 2001. As explained above, Applicants filed a complete response to the Notice to File Missing Parts on November 30, 2001, which is indicated as received by the OIPE on January 11, 2002, on the enclosed return postcard. Based on these facts, Applicants' calculations of Applicant delay is a total of 16 days rather than the 145 calculated by the USPTO. As shown in the following table, USPTO delays, as calculated by the USPTO total 356 days. **Applicants are therefore entitled to at least 340 days of PTA** (356 (USPTO delay) – 16 (Applicant delay) = 340. However, Applicants are also entitled to an **additional 32 days of patent term adjustment** for

the period of time that is three years from the filing date to the patent grant date.

**Therefore, Applicants respectfully submit that they are entitled to a total of 372 days of patent term adjustment.**

The Commissioner is hereby authorized, in accordance with 37 CFR § 1.16-1.17, to charge Deposit Account No. 50-2350 for the fee of \$200.00 to cover the requisite fee associated with filing this request as specified in 37 C.F.R. § 1.18(e) and 37 C.F.R. § 1.705(b)(1). Furthermore, the Commissioner is hereby authorized to charge any additional fee(s) which may be required regarding this application under 37 CFR § 1.16-1.17, or credit any overpayment to Deposit Account No. 50-2350. A duplicate of this document is enclosed for such purpose.

## PTO Calculation of Patent Term Adjustment of 211 Days from USPTO PAIR page

| Patent Term Adjustment (PTA) for publication number: 09/911,367 |            |                             |      |
|---|------------|-----------------------------|------|
|   |            |                             | Days |
| Filing or 371(c) Date:  | 07-23-2001 | USPTO Delay (PTO):          | 356  |
| Issue Date of Patent:   |            | Three Years:                |      |
| Pre-issue Petitions (days):                                     | +0         | Applicant Delay (APPL):     | 145  |
| Post-issue Petitions (days):                                    | +0         | Total PTA:                  | 211  |
| USPTO Adjustment (days):  | +0         | Explanation of Calculations |      |

| Patent Term Adjustment History |            |   |            |             |
|--------------------------------|------------|---|------------|-------------|
| Number                         | Date       | Contents Description  | PTO (days) | APPL (days) |
| 28                             | 02-10-2004 | Mail Notice of Allowance  | 4          |             |
| 27                             | 02-10-2004 | Mail Examiner's Amendment   | ↑          |             |
| 26                             | 02-09-2004 | Notice of Allowance Data Verification Completed   | ↑          |             |
| 25                             | 02-09-2004 | Examiner's Amendment Communication  | ↑          |             |
| 24                             | 02-09-2004 | Notice of Allowability  | ↑          |             |
| 23                             | 11-19-2003 | Date Forwarded to Examiner  | ↑          |             |
| 22                             | 10-06-2003 | Response to Election / Restriction Filed  | ↑          |             |
| 21                             | 09-10-2003 | Mail Restriction Requirement  | 352        |             |
| 20                             | 09-08-2003 | Requirement for Restriction / Election  | ↑          |             |
| 19                             | 07-09-2003 | Case Docketed to Examiner in GAU  | ↑          |             |
| 18                             | 03-23-2003 | Case Docketed to Examiner in GAU  | ↑          |             |
| 17                             | 03-07-2003 | Case Docketed to Examiner in GAU  | ↑          |             |
| 16                             | 05-22-2002 | Application Dispatched from OIPE  | ↑          |             |
| 15                             | 05-20-2002 | Application Is Now Complete   | ↑          |             |
| 13                             | 05-20-2002 | Application Dispatched from OIPE  | ↑          |             |
| 12                             | 05-20-2002 | Application Is Now Complete   | ↑          | 145         |
| 10                             | 03-14-2002 | Additional Application Filing Fees  | ↑          | ↑           |
| 9                              | 03-14-2002 | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant | ↑          | ↑           |
| 8                              | 01-11-2002 | Payment of additional filing fee/Preexam  | ↑          | ↑           |
| 7                              | 01-11-2002 | An assertion that the nature of the legal entities having property rights to the patent authorizes it   | ↑          | ↑           |
| 6                              | 01-11-2002 | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant | ↑          | ↑           |
| 5                              | 09-26-2001 | Notice Mailed--Application Incomplete--Filing Date Assigned   | ↑          | ↑           |
| 3                              | 09-25-2001 | Correspondence Address Change   | ↑          |             |
| 2                              | 07-31-2001 | IFW Scan & PACR Auto Security Review  | ↑          |             |

**Corrected Calculation of Patent Term Adjustment of 372 days**

| <b>Patent Term Adjustment Calculation System</b>  |            |                  |          |                |
|---|------------|------------------|----------|----------------|
| Docket Number: 032026-0594                        |            |                  |          |                |
| Application Number: 09/911367                     |            |                  |          |                |
| Patent Number: N/A                                |            |                  |          |                |
| Event Description                                 | Event Date | Days from Filing | PTO Days | Applicant Days |
| Application Filing Date                           | 07/23/2001 | 0                |          |                |
| Notice to File Missing Parts                      | 09/26/2001 | 65               |          |                |
| Notice to File Missing Parts + 3 months           | 12/26/2001 | 156              |          |                |
| Response to Notice to File Missing Parts          | 01/11/2002 | 172              |          | 16             |
| 14 month From Application date                    | 09/23/2002 | 427              |          |                |
| Restriction Requirement                           | 09/10/2003 | 779              | 352      |                |
| Restriction Requirement Response Received at PTO  | 10/06/2003 | 805              |          |                |
| Restriction Requirement Response Filed + 4 months | 02/06/2004 | 928              |          |                |
| Notice of Allowance                               | 02/10/2004 | 932              | 4        |                |
| 3 Year Period Starts                              | 07/23/2004 | 1,096            |          |                |
| Projected Patent Grant Date                       | 08/24/2004 | 1,128            | 32       |                |
| Totals:   |            |                  | 388      | 16             |
| PTA:  |            |                  | 372      |                |

Respectfully submitted,

Date February 20, 2004By Bernard P. Friedrichsen

FOLEY & LARDNER  
 Customer Number: 23524  
**23524**

PATENT TRADEMARK OFFICE  
 Telephone: (608) 258-4281  
 Facsimile: (608) 258-4258

Bernard P. Friedrichsen  
 Attorney for Applicant  
 Registration No. 44,689